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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,181	05/29/2001	Dana Howard Jones	513612000100	6792
25224	7590	05/24/2006	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/867,181

Applicant(s)

JONES, DANA HOWARD

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,9-16,18,21-24,26-31,34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 9-16, 18, 21-24, 26-31, 34, and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 1 and 24. All pending claims (1, 3-5, 9-16, 18, 21-24, 26-31, 34, and 36-40) were examined in this non-final office action necessitated by new grounds of rejection.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 06 March 2006, with respect to the rejection(s) of claim(s) 1, 3-5, 9-16, 18, 21-24, 26-31, 34, and 36-40 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Goldhaber under 35 USC 102 and Goldhaber and Wisner under 35 USC 103. The Applicant's argument pertaining to ON1 is moot. ON1 was withdrawn. Goldhaber does disclose distributing products, specifically discusses delivering intellectual property in digital format directly to the consumer's computers, the consumer viewing a message first and then placing the order as noted below. Also, Goldhaber specifically discloses an pushing information to the consumer rather than the consumer searching for information as noted below.

*Pertaining to ON2*

The Applicant did not traverse the examiner's assertion of official notice on the specific merits of the official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1, 3, 10-16, 18, 21-24, 26-31, 34, 37, and 38 are rejected under 35 USC 102(b) as being anticipated by Goldhaber (Paper #2, US 5,794,210).**

Goldhaber teaches all the limitations of claims 1, 3, 10-16, 18, 21-24, 26-31, 34, 37, and 38. For example, Goldhaber discloses a method of advertisers gaining the attention of consumers accessing the Internet via attention brokerage and compensating consumers who pay attention to the advertisement (please see at least title, abstract; col. 4, lines 34-35; col. 9, lines 34-36). Goldhaber discloses advertisers as sponsors embedding advertisements with content most likely to reach the advertiser's target audience referred to as linking sponsorship (see at least col. 2, lines 24-27). Goldhaber discloses decoupling advertising

from the content referred to as orthogonal sponsorship (see at least col. 5, lines 46-47). Goldhaber discloses sponsored messages being retrieved based on the consumer's profile or being pushed to the consumer based on the consumer's profile (see at least col. 8, lines 1-18). Goldhaber further discloses:

- Receiving, from a content provider, a media product: intellectual property (see at least col. 1, lines 4-7; col. 6, lines 3-7); traditional method of positively priced content comprising a television program, prerecorded music, magazine, newspaper articles, or research report is delivered digitally to the requesting consumer via consumer computer; consumer compensates the content provider (please note: one of sound, text, video data) (see at least Fig. 2; Fig. 5; col. 10, lines 9-19); orthogonal sponsorship separates content from advertisement and delivers content separately; consumer makes payment for content (see at least Fig. 6; col. 11, line 59 through col. 12, line 13).
- Providing the media product for sale at an Internet site: consumers connected to service via the Internet (see at least abstract; Fig. 1 (102); col. 1, lines 4-8; col. 3, lines 51-55; col. 5, lines 11-13; col. 6, lines 3-7; col. 9, lines 32-41).
- Restricting general public access to said media product: user logs into personalized home page to view sponsored messages targeted at the individual based on profile (see at least col. 7, line 20-47; col. 8, lines 49-58).

- Offering to a consumer access to the media product on the precondition that the consumer views a sponsor message: consumer views sponsored message, the sponsored message using a “carrot and stick” approach to ensure the consumer views the advertisement (see at least col. 5, line 55 through col. 6, line 2).
- Receiving from the consumer a request to view a sponsor message wherein the consumer submits said request in response to being offered access to the media product; facilitating display of sponsor message; allowing access to media product after said step of facilitating the display of said sponsor message: referring to Fig. 11, the consumer is being offered access to content (e.g. simulcast), the consumer clicks on the 62(3) resulting in the system receiving from the consumer a request to view a sponsor message first before placing order (see at least Fig. 11 (62(3); Fig. 13 (304, 308, 314); col. 5, lines 11-13; col. 18, lines 47-59); embedding messages with content (see at least col. 10, lines 9-37).
- maintaining a consumer activity log: creates consumer profile; maintains profile, updates profile (see at least col. 13, line 33 through col. 14, lines 56).
- authoring sponsor message: advertiser creates ad at site (see at least Fig. 8 (68, 106); col. 14, lines 17-20).

- consumer sign-up: providing personal data, contact data, profile data, taking acceptance action, password (see at least col. 12, line 45 through col. 13, line 40).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 4, 5, 36, and 40 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210) in view Wiser (Paper #2, US 6,385,596).**

Goldhaber teaches all the above as noted under the 102(b) rejection and teaches a) advertising intellectual property products, b) compensating information providers for purchased content (e.g. prerecorded music, television programs, search reports), and c) trading houses providing automatic royalty tracking (see at least col. 19, line 19 through col. 20, line 53; col. 20, lines 54-55), but does not disclose making royalty payments. Wiser teaches protecting a content owner's intellectual property rights over a network, and further teaches tracking and making royalty payments to content owners and facilitators (see at least col. 9, lines 39-53; col. 11, lines 49-61). Therefore it would have been

obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to disclose making royalty payments as taught by Wiser, in order to disclose the purpose of royalty tracking, and thereby attract content owners and facilitators to the service desiring to be paid royalties.

Goldhaber teaches all the above as noted under the 102(b) rejection, but does not disclose entering into a license agreement with the owner of the intellectual property. Wiser teaches all the above as noted under the 103(a) rejection and further teaches consumers and facilitators entering into a license agreement with the owner of intellectual property (see at least abstract; Fig. 1A (108, 116); Fig. 1B (110); col. 1, lines 45-47; col. 5, lines 56; col. 10, lines 18-48). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber and ON1 to implement licensing as taught by Wiser, in order to protect the intellectual property rights of the product owner.

- 3. Claims 9 and 39 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210) in view of Official Notice (Paper #20051121, admitted prior art regarding within the skill, hereinafter referred to as ON2).**

Goldhaber teaches all the above as noted under the 102(b) rejection and further teaches inactivating a CyberCoin to prevent a consumer from receiving additional compensation by merely accessing the same advertisement (see at



least col. 17, lines 49-52), but does not disclose barring the owner of intellectual property from pretending to be a consumer. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art at time of the invention to disclose barring the content provider from pretending to be a consumer, since it is within the skill to ascertain that content providers are capable of abusing the system as well as consumers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to disclose barring the owner of intellectual property from pretending to be a consumer as taught by ON2, in order to protect the system from abusive users, and thereby attract consumers and providers to the service.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond  
Primary Examiner  
May 22, 2006